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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,935	03/09/2005	Carsten Krischker	112740-1043	6885

29177 7590 03/29/2007
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EXAMINER

ZEWDU, MELESS NMN

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	03/29/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 10/517,935
Filing Date: March 09, 2005
Appellant(s): KRISCHKER ET AL.

MAR 29 2007

Technology Center 2600

Krischker et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/28/07 appealing from the Office action
mailed 2/14/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,592,546	Takahashi	01-1977
WO 99/45687	Yablon	09-1999

ITU-T Recommendation H.245; (XP-002199601), September 1998; sections 5.2-5.9.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-24, 29-32 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablon (WO 99/45687) in view of ITU-T Recommendation H.245, sections 5.2-5.9; (XP-002199601), hereafter, **ITU-T Recommendation**.

As per claim 22: The preamble does not further limit the claim, and is considered as an intended use. Regarding the features of claim 22, Yablon teaches:

signaling a call from a second telecommunications device (calling device) of a second telecommunications subscriber to a first telecommunications device of a first telecommunications subscriber (recipient device) (see fig. 16; page 23, lines 10-12). (Fig.16) shows a

“Handshake”, procedure for establishing a call between a first and a second telecommunication devices (see particularly step 1: Handshake).

transmitting subscriber data from the second telecommunications device to the first telecommunications device in accordance with the device information (see fig. 16; page 23, lines 10-23). (Fig.16, steps 1 and 2) shows that subscriber data/information (device's capability) is determined (1st step) and based on the determination, information is transmitted (2nd step). Furthermore, the first and second devices exchange each other's device information bi-directionally (see fig. 16, 1st and 2nd steps). But, Yablon does not explicitly teach about device information that indicates a type of subscriber data that the first telecommunication device wants to receive, as claimed by applicant. However, in the same field of endeavor, the ITU-T recommendation teaches about a capability exchange wherein “the total capability of a terminal to receive and decode various signals is made known to the other terminal by transmission of its capability set (see entire document, particularly page 1, paragraphs 1-3). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Yablon with the ITU-T

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Recommendation for the advantage of enabling a transmitting terminal to offer choice of preferred mod to a receiver (see page 1, 3rd paragraph).

As per claim 30: The preamble does not further limit the claim, and is considered as an intended use. Regarding the features of claim 30, Yablon teaches:

signaling a call from a second telecommunications device of a second telecommunications subscriber to a first telecommunications device of a first telecommunications subscriber (see fig. 16; page 23, lines 10-23); transmitting subscriber data from the first telecommunications device (recipient device) to the second telecommunications device (calling device) in accordance with the device information (see fig. 16; page 23, lines 10-18). It is shown in (fig. 16, steps 1 and 2) that a calling device and the recipient device exchange information on their respective capabilities (step 1) so as to enable actual transmission of information (subscriber data) (see second step) according to agreed upon protocol. Furthermore, devices' information (capability) is exchanged bi-directionally. But, Yablon does not explicitly teach whether or not the information indicates a type of subscriber data that the first telecommunication device wants to receive, as claimed by applicant. However, in a related field of endeavor, the ITU-T

Recommendation teaches about a capability exchange wherein "the total capability of a terminal to receive and decode various signals is made known to the other terminal by transmission of its capability set (see entire document, particularly page 1, paragraphs 1-3). Motivation is same as provided in the rejection of claim 22.

As per claim 38: The preamble does not further limit the claim and is considered as an intended use. Regarding the features of claim 38, Yablon teaches:

a memory for storing subscriber data (see fig. 16; page 23, lines 5-9);
a facility for receiving device information of a further telecommunications device (see fig. 16, steps 1 and 2; page 10-23);
a facility for transmitting particular subscriber data from the memory to the further telecommunications device depending on the device information received (see fig. 16, steps 1 and 2; page 23, lines 10-23). Fig. 16 includes the facility; and the particular subscriber data (e.g. video) is determined based on handshake information exchanged between the two devices. But, Yablon does not explicitly teach about information, which indicates components of subscriber data that the telecommunications device wants to receive, as claimed by applicant. However, this differential feature is

taught by the ITU-T Recommendation (see page 1, paragraphs 1-5).

Motivation is same as provided in the rejection of claim 22 above.

As per claim 40: The preamble does not further limit the claim and is considered as an intended use. Regarding claim 40, Yblon teaches:

a memory for storing device information (see fig. 16; page 23, lines 5-9);

a facility for transferring the device information from the memory to the further telecommunications device (see fig. 16; page 23, lines 5-9). Fig. 16 includes the facility/system.

a facility for receiving subscriber data from the further telecommunications device depending on the device information transmitted (see fig. 16, the first and second steps; page 23, lines 10-23). Fig. 16 includes the facility/system; and transfer of information (subscriber data) is based on the handshake result between the calling and called parties. Furthermore, since, the system is bi-directional, data would have been transmitted from either device and received by the other. But, Yablon does not explicitly teach about information, which indicates a type of subscriber data that a further telecommunications device wants to receive, as claimed by applicant. However, this differential feature is taught by the

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ITU-T Recommendation (see page 1, paragraphs 1-5). Motivation is same as provided in the rejection of claim 22 above.

As per claim 23: Yablon teaches a method, wherein at least one of the of the first and second telecommunications devices stores transmission information which indicates which subscriber data has been transmitted from the other respective telecommunications device (see page 23, lines 18-23; page 29, lines 9-20). The prior art identifies caller, electronic mail, text information, etc., which are transmission information. Furthermore, the preamble is considered as an intended use, since it does not further limit the claim.

As per claim 31: the feature of claim 31 is similar to the feature of claim 23. Hence, claim 31 is rejected on the same ground and motivation as claim 23.

As per claim 24: Yablon teaches a method, wherein the transmission information is transmitted from one telecommunications device to the other telecommunications device (see fig. 16; page 23, lines 10-15) with the subscriber data (see page 29, lines 9-20). The preamble is considered as an intended use.

As per claim 32: the feature of claim 32 is similar to the feature of claim 24. Hence, claim 32 is rejected on the same ground and motivation as claim 24.

As per claim 29: the ITU-T Recommendation teaches a method, wherein at least one of the first and second telecommunications devices stores release information which indicates which subscriber data should be transmitted to the respective other telecommunications device (see page 1, paragraphs 1-3). Storing "release information" is obvious from the fact that information, which indicates, which subscriber data should be transmitted to the respective other telecommunications device is exchanged.

As per claim 37: the feature of claim 37 is similar to the feature of claim 29. Hence, claim 37 is rejected on the same ground and motivation as claim 29.

As per claim 39: the feature of claim 39 is similar to the feature of claim 23, with the exception of the feature, "a further memory" (additional memory), which is provided by Yablon (see page 23, lines 5-9). The preamble of claim 39 is considered as an intended use. Hence, claim 39 is rejected on the same ground and motivation as claim 23.

Claims 25, 27 and 33, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claims 22 and 30 above, and further in view of Takahashi (US 5,592,546).

As per claim 25: while the preamble of claim 25 is considered as an intended use, the above references do not explicitly teach about a method, wherein the transmission information is assigned historical data, which references the transmitted subscriber data, as claimed by applicant. However, in a related field of endeavor (telecommunications device), Takahashi teaches about a telephone number retrieval function by using historical information, wherein the technique/method includes a memory for registering remote terminal name and telephone number pairs, in the order of time the respective pairs have been registered, together with respective identification numbers relevant to the respective pairs (the identification numbers being assigned to the respective information pairs according to historical sequence in which the pairs are registered therein), including sort table for storing therein the above identification numbers in the alphabetical order with respective registered names; a transmission/reception history area for storing therein information including the remote terminal telephone numbers used for transmission/reception operations using memory dialing

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method and usage order table for storing information concerning the frequencies with which the respective pairs have been used in the transmission/reception (see fig. 2, particularly box 7; abstract; col. 3, lines 16-44; col. 10, lines 14-28). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references for the advantage of improving memory-dialing efficiency (see col. 3, lines 14-15), a feature which telephone devices are known to have.

As per claim 33: the feature of claim 33 is similar to the feature of claim 25. Hence, claim 33 is rejected on the same ground and motivation as claim 23.

As per claim 27: while the preamble of claim 27 is considered as non-limiting, Takahashi teaches a method, wherein the subscriber data to be transmitted is referenced to current historical data (see col. abstract; col. 3, lines 20-44).

As per claim 35: the feature of claim 35 is similar to the feature of claim 27. Hence, claim 35 is rejected on the same ground and motivation as claim 27.

Allowable Subject Matter

Claims 26, 28, 34 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims

(10) Response to Argument

Argument I: with regard to claims 22-24, 29-32 and 37-40, particularly claims 22, 30, 38 and 40, appellants argue the cited art, alone or in combination fail to disclose the feature of "sending device information from the first telecommunications device to the second telecommunications device which indicates a type of subscriber data that the first telecommunication device wants to receive" as recited in independent claim 22 and similarly recited in independent claims 30, 38 and 40.

Response I: examiner respectfully disagrees with the argument. In appropriately analyzing the particular feature, one of ordinary skill in the art would interpret it as follows. First, there is "a communication between two subscriber devices wherein one of the subscriber devices sends to the other an indication of a type of subscriber data it wants to receive". Second, the subscriber/user is not clearly shown to be actively participating in the selection and transmission of the data being communicated; hence, it is a device -to-device communication. Third, the feature, "--- the first telecommunications device wants to receive", is subjective; associated with a human feeling. Only the implied subscriber/user could have determined what it wants. Thus,

examiner interprets this later feature, as the first telecommunications device is capable to receive. To that effect, Yablon's reference discloses a communication between two devices (see at least, fig. 16) wherein the devices introduce each other's brand and particularly in step (e) one of the devices asks the other "**what do you have for me?**" and the other device replies (in step f), the type of subscriber data as phone #, text, voice mail pictures, video, facsimile. But, as described in the body of the rejection above, Yablon does not explicitly teach about device information indicative of a type of subscriber data that the first telecommunications device (requesting telecommunications device) wants (is capable of) to receive. However, the ITUT Recommendation H.245 cures this deficiency. It is a standard for capability exchange procedures and requires that "the total capability of a terminal to receive and decode various signals is made known to the other terminal by transmission of its capability set", so as to provide a choice of preferred modes to the receiver. Even, if one arguably accepts the notion that the device **is capable of wanting**, it could have not wanted what it is not capable or receiving. In conclusion, Yablon discloses at least one subscriber, inquiring information about a subscriber data from another subscriber (i.e., (text, voice, etc. data). Device information associated with a subscriber data type is not clear from Yablon. The ITU-T Recommendation provides for this shortcoming a teaching along with a motivation, i.e., only multimedia signals that can be received and treated appropriately by a receiver are transmitted. Hence, examiner did not find the argument persuasive, and maintains the rejection.

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Argument II: with regard to claims 22-24, 29-32 and 37-40, particularly claims 22, 30, 38 and 40, appellants attempt to argue against examiner's interpretation of the word/term, wants, by asserting, "applicant submits that such an interpretation runs afoul of the requirement that, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." And further elaborates the meaning of the word, based on the specification, as "selectively choose available subscriber data for the device."

Response II: examiner respectfully disagrees with the argument. In that this argument may have been implied, but not clearly claimed as such. The word, 'want' is used in the specification as an alternate to the words, 'can' and 'able' (see spec. paragraphs 0008 and 0035), and consequently has been given the broadest interpretation (device capability). Appellants import the feature of "selectively --- " from the specification to support this line of argument, which is contrary to the rules and practices required by the Office (see MPEP § 2181- § 2186). Therefore, the argument is found to be unpersuasive because it is based on a feature that was not claimed as clearly as being argued.

Argument III: with regard to claims 22-24, 29-32 and 37-40, particularly claims 22, 30, 38 and 40, appellants argue "if the term indicates "a capability of a communication device to receive data," as interpreted by the examiner, there is no selective choice being made: the device will receive all of the data according to its capability, whether or not it "wants" that data (i.e. selects to receive it)."

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Response III: examiner respectfully disagrees with the argument. In that, this argument is being made based on a feature, 'selective choice being made', that was not claimed as clearly as being argued.

Argument IV: with regard to claims 22-24, 29-32 and 37-40, particularly claims 22, 30, 38 and 40, appellants further argue by saying "under Yablon and ITU recommendation, the terminal communicates to another terminal or telecommunications device that is able to receive video data, but nothing is provided for the management and blocking of the data."

Response IV: examiner respectfully disagrees with the argument and maintains the rejection since the argument is being made based on the feature, "management and blocking of the data", that was not claimed in a manner as being argued.

Argument V: with regard to claims 22-24, 29-32 and 37-40, particularly claims 22, 30, 38 and 40, appellants assert, "Yablon is silent regarding minimizing the data flow ("transmitting subscriber data ... in accordance with the device information") between two terminals or telecommunication devices, particularly in light of fig. 16"; "This configuration is a not effective way of exchanging device information generating a high data flow, and also teaches away from the recited claims."

Response V: examiner respectfully disagrees with the argument. In that the argument based on the features, **minimizing the data flow, generating high data rate** are is unrelated to the claims and is based on unclaimed subject matter. And the argument of teaching away based on these unclaimed features is also considered as an argument based on a subject matter that was not claimed in a manner being argued.

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Argument VI: appellants further argue, "the disclosure in the ITU-T Recommendation (5-2) is duplicative of the disclosure in Yablon (see page 23, lines 10-21."

Response VI: examiner respectfully disagrees with the argument, in that this argument is not related to the claims or any claim.

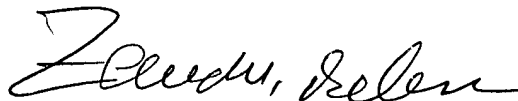
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Meless Zewdu (Examiner of the record),




26 March 2007.

Conferees:

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